

REMARKS

Claims 1-50 were examined. By this Amendment, claims 3, 4, 13, 14, 21, 22, 29, 30, 37, 38, 45 and 46 are amended, and claims 5, 6, 15, 16, 23, 24, 31, 32, 39, 40, and 47 and 48 are canceled. Thus, claims 1-4, 7-14, 17-22, 25-30, 33-38, 41-46 and 49-50 are pending in the application. Applicants respectfully request reconsideration of the Application in view of the foregoing amendments and the following remarks.

Drawings

The Patent Office Objected to the drawings under 37 C.F.R. § 1.83(e) because they did not show the locking device claimed in claims 3-6, 13-16, 21-24, 29-32, 37-40 and 46-48.

The specification and drawings have been amended to better describe the locking device which is identified by the reference numeral 105. Additionally, claims 3, 13, 21, 29, 37 and 46 have been amended to now recite the locking device illustrated and described, while claims 4, 14, 22, 30, 38 and 47 have been amended to recite particular locking device structures described in the specification. Claims 5, 6, 15, 16, 23, 24, 31, 32, 39, 40, and 47 have been canceled.

Accordingly, it is submitted that the objection under 37 C.F.R. § 1.83(e) is obviated, and withdrawal of the objection is requested.

Claim Rejections – 35 U.S.C. §§ 102, 103

The Patent Office rejected claims 43-44 and 49-50 under 35 U.S.C. § 102(e) as being anticipated by Bednar et al., U.S. Patent No. 6,851,193 (Bednar). The Patent Office rejected claims 46-48 under 35 U.S.C. § 103(a) as being unpatentable over Bednar. Finally, the Patent Office rejected claims 1-42 under 35 U.S.C. § 103(a) as being unpatentable over Bednar in view of Sellmann, U.S. Patent No. 6,473,975. Claims 5, 6, 15, 16, 23, 24, 31, 32, 39, 40, and 47 have been canceled obviating the rejection of these claims. Applicants respectfully traverse the rejection of the remaining claims for at least the following reasons.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation

requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Similarly, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

The primary reference, Bednar, fails to disclose, teach or suggest a keyless shoe lock assembly for a reciprocating saw having a shoe, a shoe bracket for supporting the shoe, a lock plate enmeshed with the shoe bracket for locking the shoe bracket, and a pin rotationally disposed of the shoe bracket and lock plate for forcing the shoe bracket against the lock plate for locking the shoe as presently claimed in independent claims 1, 11, 19, 27, 35 and 43. Instead, Bednar teaches a reciprocating saw having a keyless shoe lock consisting of a shoe support member that includes a plurality of notches, which is supported in a shoe retaining plate so that it slides within the shoe retaining plate. A locking member engages one of these notches to lock the shoe bracket preventing inward or outward movement of the shoe. Nowhere does Bednar teach or suggest that this locking member forces the shoe support member against the shoe retaining plate. The shoe retaining plate functions only as a support for the shoe support member as the shoe support member is slid inwardly or outwardly to adjust the position of the shoe. Specifically, Bednar discloses that the shoe retaining plate 206

is supported in a slot 210 (see FIG. 2) defined in the housing 14 to form a channel in which the shoe support member 202 is movable. The retaining plate 206 supports the shoe support member 202 along at least two walls (i.e., the bottom wall and a side wall). In an alternative embodiment (see FIG. 8A), the retaining plate 206 includes hardened wear surfaces provided by contact portions 212 to form a channel which supports the shoe support member 202 on all four sides.

Bednar, column 10, lines 17-26. Bednar, further discloses that:

[i]n the locked position (FIG. 2), the locking member 218 is pivoted so that the locking member 218 engages the teeth

214. The rounded portion of the locking member 218 engages the forward rounded surface of each of a pair of teeth 214. In this manner, the shoe support member 202 is substantially prevented from moving relative to the housing.

To adjust the position of the shoe plate 194 relative to the housing 14, the operator moves the lever 226 to the release position (FIG. 9). As the lever 226 is pivoted to the release position, the locking member 218 is pivoted relative to the shoe support member 202. In the release position (FIG. 9), the locking member 218 is pivoted so that the locking member 218 does not engage the teeth 214. The teeth 214 are movable beneath the flat surface 222 of the locking member 218. With the lever 226 maintained in the release position, the operator can adjust the shoe plate 194 relative to the housing 14 so that the shoe plate 194 is in an optimum position for cutting.

Bednar, column 10, line 50 to column 11, line 2. Thus, Bednar nowhere discloses a *lock plate enmeshed with the shoe bracket* and a pin rotationally disposed of the shoe bracket and lock plate *for forcing the shoe bracket against the lock plate* as presently claimed.

The ancillary reference, Sellmann, fails to make up for this defect in the Bednar reference. Sellmann teaches a saw guide for a chain saw that is clamped between the motor housing of the saw and a tightening element. Detent plates, which have teeth arranged in a saw tooth pattern, are fixedly connected to the saw guide and the tightening element and so that displacement is prevented in the loosening direction of the chain but permitted in the tightening direction of the chain. Thus, Sellmann, either alone or in combination with Bednar, also fails to teach or suggest a lock plate enmeshed with the shoe bracket and a pin rotationally disposed of the shoe bracket and lock plate for forcing the shoe bracket against the lock plate.

There exists no suggestion or motivation to modify and combine the Bednar and Sellmann references to achieve Applicants' invention. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

Thus, the Patent Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

Accordingly, it is respectfully submitted that the Patent Office has failed to establish *prima facie* anticipation or obviousness of claims 1-50 under U.S.C. §§ 102(e), 103(a). Withdrawal of the rejection of claims 1-4, 7-14, 17-22, 25-30, 33-38, 41-46 and 49-50 which remain in the application is therefore requested.

CONCLUSION

The application is respectfully submitted to be in condition for allowance of all claims. Accordingly, notification to that effect is earnestly solicited.

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Amendments to the Drawings

The attached sheet of drawings includes changes to FIG. 2. This sheet, which includes only FIG. 2, replaces the original sheet including FIG. 2. In FIG. 2, the reference number 105 has been added.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes



Appl. No. 10/685,351
Amdt. Dated July 15, 2005
Reply to Office Action of October 17, 2005
Annotated Sheet Showing Changes

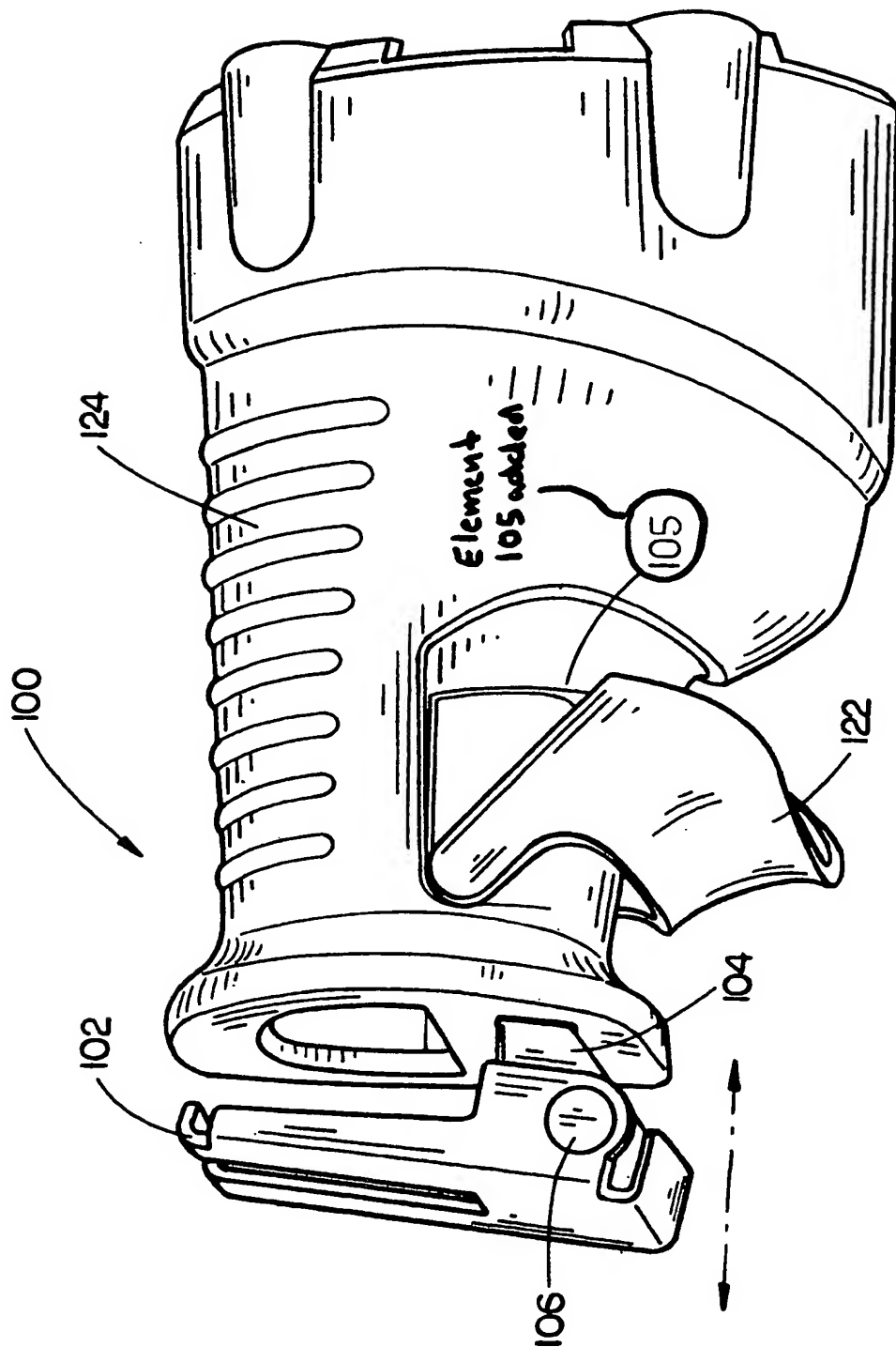


FIG. 2